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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/766,167	01/28/2004	T. Andrew Simonton	4002-3462/PC947.00	3383

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EXAMINER

SWEET, THOMAS

ART UNIT PAPER NUMBER

3738

DATE MAILED: 01/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

TWA

Office Action Summary	Application No.	Applicant(s)	
	10/766,167	SIMONTON ET AL.	
	Examiner	Art Unit	
	Thomas J. Sweet	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 4, 22 and 35-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-13 and 18-29 is/are rejected.
- 7) ☒ Claim(s) 14-17 and 30-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 May 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/04, 5/04, 12/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Claims 4, 22 and 35-48 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 12/29/2005.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 5- 9, 11-13, 18-21, 23-26 and 28-29 are rejected under 35 U.S.C. 102(b) as being anticipated by Myers et al (WO 01/68005). Myers et al discloses an implant for the spinal column (figs. 1 and 7, and related portions of the specification), comprising: an elongated body (2) positionable in a spinal disc space (as shown in fig. 13), said body comprising a convexly curved upper surface (24) orientable toward an endplate of an upper vertebra and a convexly lower surface (26) orientable toward an endplate of a lower vertebra: a leading end portion (20) and an opposite trailing end portion (22); a pair of sidewalls (4 and 5) extending between said leading end portion and said trailing end portion; a cavity (3) between said leading end portion, said trailing end portion, and said sidewalls, said cavity opening at said upper surface (as seen in figs. 1 and 7) and said lower surface of said body (through the entire height); and wherein said body includes a height between said upper and lower surfaces (H) corresponding to a desired disc space height between the upper vertebra endplate and the lower vertebra endplate (as shown

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in fig. 13), wherein said leading end portion is structured (rounded) which is fully capable of insertion into the disc space collapsed condition and said height is sized to restore the collapsed disc space to the desired disc space height as the body is inserted in the collapsed disc space.

With regard to claim 2, said upper surface and said lower surface are each convexly curved along an entire length of said body (not accounting for projections 9 or 106 and recesses 13 or 104, 107 and 108, similar to the teeth of the present invention).

With regard to claims 3 and 21, said leading end portion (20) includes a nose rounded between said upper surface and said lower surface.

With regard to claims 5 and 20, said sidewalls are parallel to one another (as see in fig.4 and described in the related text, i.e. planar).

With regard to claims 6 and 23, said body includes: a first notch (16) in a first one of said sidewalls, and a second notch (16') in a second one of said pair of sidewalls, said first and second notches opening at a proximal end wall of said body.

With regard to claims 7 and 24, said proximal end wall is planar (between the rounded edges) and extends between said sidewalls and said upper and lower surfaces.

With regard to claims 8 and 25, further comprising a coupling member (fig. 8) having first (168) and second fingers (170) positionable in respective ones of said first (16) and second notches (16') to secure said body to said coupling member.

With regard to claims 9 and 26, said coupling member comprises a distal portion of an insertion instrument (150).

With regard to claim s11 and 28, said upper and lower surfaces each include a number of engagement members there along and projecting outwardly therefrom to engage bony tissue of

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the adjacent vertebral endplate when said body is positioned in the spinal disc space (projections 8, 9, 24 and 26 or 106 and recesses 13 or 104, 107 and 108, similar to the teeth of the present invention).

With regard to claims 12-13 and 29, said engagement members comprise a number of teeth along portions of said sidewalls extending along said cavity (fig. 7) and said upper and lower surfaces are substantially smooth along said leading end portion and said trailing end portion (98 and 100).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 10 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Myers et al in view of Branch et al (US 6174311). Myers et al discloses an implant for the spinal column as discussed above. However, Myers et al remains silent as to the width of said coupling member between outer lateral surfaces of said fingers is less than a width between outer lateral surfaces of said sidewalls at least when said fingers are in said notches. Branch et al discloses another implant for the spinal column including a delivery device (figs. 7-10) having the width of said coupling member (60 and 62) between outer lateral surfaces of said fingers is less than a width between outer lateral surfaces of said sidewalls (as shown in fig. 11) at least when said fingers are in said notches for the purpose of clearance during deliver (col 10, lines 14-38) using delivery device (figs. 7-10). It would have been obvious to one of ordinary skill in the art at the

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time the invention was made to modify the implant of Myers et al to accommodate the delivery device of Branch et al so that the coupling member between outer lateral surfaces of said fingers is less than a width between outer lateral surfaces of said sidewalls at least when said fingers are in said notches so that the device could be delivered from the deliver device of Branch et al. Such a modification amounts to mere substitution of one functionally equivalent delivery device for another within the art of spinal implants.

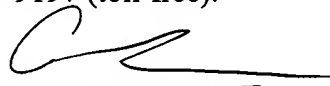
Allowable Subject Matter

Claims 14-17 and 30-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:30 am - 5:00pm, M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



CORRINE McDERMOTT
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